



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/195,905 11/19/98 TATHAM

C 8770157-0004

□

LM12/0329

EXAMINER

ORANGE & ASSOCIATES
TORONTO DOMINION BANK TOWER
TORONTO DOMINION CENTRE
P O BOX 190 SUITE 3600
TORONTO ON M5K 1H6
CANADA

AIR MAIL

ALAM, S

ART UNIT

PAPER NUMBER

2771

DATE MAILED:

03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

see attachment

Office Action Summary

Application No. 09/195,905	Applicant(s) Tatham et al.
Examiner Shahid Alam	Group Art Unit 2771



Responsive to communication(s) filed on Nov 19, 1998

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-15 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2771

DETAILED ACTION

1. This action is responsive to communication filed on November 19, 1998.
2. Claim 1-15 are pending in the case. Claims 1, 2, 13, 14 and 15 are independent claims.
3. Claims 1-9 and 12-15 are rejected under 35 U.S.C. 102(e) and claim 11 is rejected under 35 U.S.C. 103(a).

Priority

4. This application repeats a substantial portion of prior Application No. 08/955,569, filed October 22, 1997, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application.
5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on October 22, 1997. It is noted, however, that applicant has not filed a certified copy of the above application as required by 35 U.S.C. 119(b).
6. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Canada on 19 November 1997. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath or declaration does not acknowledge the filing of any foreign application. A new oath or declaration is required in the body of which the present application should be identified by application number and filing date.

Art Unit: 2771

Drawings

7. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objections

8. Claim 7 is objected to because of the following informalities: claim 7, after "wherein," there is a misspelled word "en".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 1-9 and 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Number 5,793,972 issued to Terence Shane ("Shane").

With respect to **claim 1**, Shane discloses a system for providing a virtual office, comprising:

(I) an Internet-connected server having input and access capabilities (column 2, lines 59-65);

Art Unit: 2771

- (ii) a means on the server for receiving instructions input from a first user and for creating a dedicated Internet site based on the received instruction (column 2, lines 65-67 and column 3, lines 1-2);
- (iii) means for communicating existence of the dedicated Internet site to a nominated second user (column 3, lines 20-25);
- (iv) means for accessing contents of the dedicated Internet site by the second user via a web-browser installed on the second user (column 5, lines 4-7).
- (v) means for storing information in the dedicated Internet site input via a web-browser installed at the first or the second user (column 2, lines 28-39).

With respect to **claim 2**, Shane discloses a system to provide a team of user with Internet-based groupware application functionality, comprising:

- (I) an Internet-connected server having a means for receiving an initiate instruction from a primary user (column 2, lines 59-65);
- (ii) a mean for creating a dedicated site on the server in response to the initiate instruction (column 2, lines 65-67 and column 3, lines 1-2);
- (iii) means for sending information about the existence of the site to at least one secondary user nominated by the primary user (column 9, lines 11-18 and 50-52);
- (iv) means to receive information at the dedicated site sent by the at least one secondary user using a web browser (column 5, lines 41-45);

Art Unit: 2771

- (v) means to store information at the dedicated site at the request of the primary and the at least one secondary user (column 2, lines 28-39 and column 9, lines 29-34);
- (vi) means to permit processing of the information stored at the dedicated site by the primary and the at least one secondary user (column 5, lines 25-30, 41-45 and column 6, lines 1-3); and
- (vii) means to download stored and processed information to the primary user and the at least one secondary user for display via a web browser (column 2, lines 65-67, column 3, lines 1-3 and column 5, lines 8-11).

As to **claim 3**, the primary user sends the initiate instruction via a web-browser (column 5, lines 25-30).

As to **claim 4**, the means to receive information comprises a web-browser (column 5, lines 42-50).

As to **claim 5**, the server has a unique URL address (column 5, lines 46-47).

As to **claim 6**, the server contains an address database of communication addresses for users connected to the Internet (column 2, lines 28-39).

As to **claim 7**, external user's address can be added to the address database (column 4, lines 33-39 and 47-49).

As to **claim 8**, a user accessing the communication network is assigned a unique personal workspace which provides the user with access to the features of the network assigned to the user (column 4, lines 27-32).

Art Unit: 2771

As to **claim 9**, a user is assigned a password enabling access to predefined sites within the server (column 4, lines 33-39 and 47-49 and column 7, lines 19-23).

As to **claim 12**, the means to send information comprises E-mail (column 8, lines 17-19 and column 9, lines 39-41).

With respect to **claim 13**, Shane discloses a method for providing a communication network, comprising:

- (I) providing an Internet-connected server having upload and download capabilities (column 2, lines 55-67 and column 3, lines 1-3);
- (ii) receiving instructions uploaded from a first user and for creating a dedicated Internet site on the server, the dedicated site having a unique name based on the received instructions (column 2, lines 65-67 and column 3, lines 1-2);
- (iii) communicating the existence of the dedicated Internet site to a nominated second user (column 3, lines 20-25);
- (iv) downloading contents of the dedicated Internet site to the second user via a web-browser installed at the second user (column 2, lines 65-67 and column 3, lines 1-3).
- (v) storing information in the dedicated web-site uploaded via a web-browser installed at the first or the second user (column 2, lines 28-39 and column 2, lines 29-34).

Claim 14 is essentially the same as claims 1 and 2, except it recites a method and therefore, the subject matters of claim 14 are rejected for the same reasons as in claims 1 and 2 above.

Art Unit: 2771

Claim 15 is essentially the same as claims 1 and 2, except it recites a data carrier and therefore, the subject matters of claim 15 are rejected for the same reasons as in claims 1 and 2 above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shane.

With respect to claims 10 and 11, Shane teaches all the limitations in the above claim, except he does not explicitly indicate the workgroup activity application.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to modify the system because an e-mail can be used for any of these purposes as in the workgroup activity application, like project collaboration, discussion, issue management, change control and software management.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Number 5,557,726 issued to Yoshizawa
U.S. Patent Number 5,548,506 issued to Srinivasan

Art Unit: 2771

Contact Information

Direct inquiries concerning this communication should be directed to Shahid Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Yen Vu, can be reached at (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications intended for entry)

or: (703) 305-9724 or (703) 308 6606 or (703) 308-5403 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia 22202, Sixth Floor (Receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Shahid Alam

Patent Examiner, AU 2771

March 23, 2000



KIM YEN VU
PRIMARY EXAMINER